Remarks

According to the Office Action, prosecution is reopened in connection with the above-identified patent application based on the appeal brief that was filed. The Office Action indicates that Applicant must exercise one of the following options: file a reply under 37 C.F.R. §1.111 or reinstate the appeal.

Applicant hereby elects to file this above-titled Reply Under 37 C.F.R. §1.111.

Claims 1, 4, and 6-18 are pending. With this Reply, claims 1 and 13 are amended and new claim 19 is added. Upon entry of the current amendments, claims 1, 4, and 6-19 are pending.

Applicant submits that the claim amendments are fully supported by the application as originally filed and do not present new matter.

Claims 1 and 13 are amended to make it grammatically clear that the facial expression of a given playpiece corresponds to the given emotion generally symbolized by the playpiece. Claim 1 is also amended to remove functional language unnecessary to the article claim. Support for this amendment can be found in the application as originally filed at, e.g., page 3, lines 4-6. New independent claim 19 is similar to independent claim 1, however claim 19 expressly recites that the "unique shape is symbolic of the emotion indicated by the facial expression." Support for new claim 19 can be found throughout the application as originally filed, e.g., at page 5, lines 15-25.

No fee(s) are believed to be due for adding independent claim 19 because the total number of pending claims is not more than twenty and the number of pending independent claims is not more than three. However, if any fee(s) are due for adding claim 19, please charge all of the appropriate fee(s) to the Kagan Binder Deposit Account No. 50-1775 and notify us of the same.

Applicant respectfully requests reconsideration and further examination of the application in view of the amendments above and remarks below.

New Grounds of Rejection

Claim Rejections – 35 U.S.C. § 102

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by a document showing "What a Character" Seven Dwarfs figurines.

Applicant respectfully traverses this rejection because the "What a Character" reference does not teach each and every element of claim 1.

Claim 1 recites an interactive toy that includes particular playpieces and a particular container. Each playpiece features:

- being generally symbolic of a particular emotion;
- a unique color with respect to the other playpieces;
- a unique shape with respect to the other playpieces; and
- a unique visually discernible facial expression with respect to the other playpieces, said facial expression corresponding to the particular emotion and comprising eyes and a mouth.

The figurines displayed in the "What a Character" reference are not "playpieces," are not each "generally symbolic of a particular emotion," and do not each have a "unique visually discernible facial expression with respect to the other playpieces."

The "What a Character" reference does not teach "playpieces," as claimed. Playpieces of the present invention are typically handled by a given child multiple times during the course of play (see the specification at, e.g., page 2, lines 20-30). The figurines displayed in the "What a Character" reference are made of chalk and are delicate. According to the express terms of the "What a Character" reference, the dwarf figurines are for display purposes, not playing.

The "What a Character" reference does not teach a plurality of playpieces that are each "generally symbolic of a particular emotion," as claimed. For example, two of the dwarf figurines are labeled "sneezy" and "sleepy." Sneezing is a physical response, not an emotion. Similarly, sleepy is a physical condition not an emotion.

Finally, the "What a Character" reference does not teach a plurality of playpieces that are each "unique visually discernible facial expression with respect to the other playpieces," as claimed. For example, Applicant viewed the website

http:///www.whatacharacter.com/p-s/s--page16.htm. and observed that the first, third, fourth, fifth, and seventh dwarfs positioned to the right of Snow White do not unambiguously have unique facial expressions. Moreover, Applicant viewed other pictures of the Seven Dwarfs on the internet which showed most of the dwarfs generally smiling except for Grumpy.

In addition, Applicant notes that the "What a Character" reference does not even remotely teach the shape feature of claim 19. More specifically, a plurality of playpieces where each playpiece has a unique shape that is symbolic of the emotion indicated by the facial expression.

Accordingly, it is respectfully requested that the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by "What a Character" Seven Dwarfs figurines, be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 4, 10, 13-15 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Solomon (U.S. Pat. No. 4,341,521) in view of Sparks (U.S. Pat. No. 4,378,215) and Shaver et al. (U.S. Pat. No. 5,092,778).

Applicant respectfully traverses this rejection because:

- The Solomon reference (psychotherapeutic tool book) is so far afield from the Sparks reference (device for teaching sign language) that is improper to pull aspects of the Sparks reference into the Solomon reference;
- The proposed modification of the puppets in the Solomon reference based upon the Sparks and Shaver et al. references is contrary to the express requirements of Solomon and eliminates features that are key to Solomon's teachings; and
- It is not seen how Shaver et al. can make it obvious to use multiple features in combination (e.g., unique facial expression and unique color) with a puppet of Solomon when it is essential to the intended function of the Shaver et al. playpieces that features remain segregated among different groups of playpieces; and further that these groups must be presented to the user in succession, not in integrated fashion.

The primary reference, Solomon, relates to a psychotherapeutic tool-book that includes multiple pages illustrating different situations a child may have experienced and six puppets depicting the same character (e.g., the child patient), where each puppet differs only by its facial expression that is indicative of a different emotion (see Solomon at col. 2, lines 13-37 and Figure 1). Solomon emphasizes that each puppet should be the same character (e.g., child) and that each puppet should be neutral with respect to social, cultural, racial, and ethnic background, so that any child of a given gender can identify with the character represented by the puppets (see Solomon at col. 2, lines 40-45). Puppets 21-26 in Figure 1 of Solomon appear so neutral, that they even appear gender neutral. In use, a therapist can discuss the illustrations with a child, ask the child to pick a puppet that depicts how the child felt about the situation, and allow the child to position the puppet in a space on the page for the puppet selected by the child (see Solomon at col. 2, lines 56-68). When the toolbook is not being used, the puppets can be stored in pocket 41 (see Solomon at col. 2, lines 52-54).

In comparison to independent claims 1 and 13, the Solomon puppets lack a unique color and unique shape among each of the puppets. And in comparison to independent method claim 13, the Solomon method lacks a container into which the playpieces may be independently stored or withdrawn during the course of play. In addition, Applicant notes that Solomon clearly lacks the shape feature of new claim 19. More specifically, a plurality of playpieces where each playpiece has a unique shape that is symbolic of the emotion indicated by the facial expression.

The proposed combination of Solomon and Sparks is improper. The Solomon reference is so far afield from the Sparks reference that is improper to pull aspects of the Sparks reference into the Solomon reference. Sparks does not even remotely discuss psychotherapeutic tools and/or methods such as that of Solomon. The Sparks reference relates to teaching sign language. The Sparks reference relates to three-dimensional figures (hands and human beings) for teaching the manual alphabet to the blind and/or deaf (see Sparks at the Abstract and Figures 1-3). Why would a child therapist studying the Solomon reference even consider supplementing the teachings of the Solomon reference with a reference that teaches a foreign language such as sign language? By analogy, proposing the Solomon/Sparks combination is just like proposing that a heart surgeon studying a heart

surgery reference would supplement the heart surgery reference with a sign language reference.

Also, the proposed modification of the puppets in the Solomon reference based upon the Sparks and Shaver et al. references is contrary to the express requirements of Solomon and eliminates features that are key to Solomon's teachings.

With respect to combining Solomon and Sparks, the Office Action concludes that it would have been obvious to modify the Solomon puppets to each have a unique shape because Figure 3 of Sparks shows a boy and girl communicating via different body language poses (see the Office Action at page 8). However, as discussed above, Solomon instructs that the character of her puppets is to be the same (i.e., the child patient) and that that her puppets should differ only by the facial expression indicative of a particular emotion. Viewing puppets 21-26 in Figure 1 and reading the text at column 2, lines 13-45 of the Solomon reference underscore this "sameness" requirement among each of the puppets. As also discussed above, Solomon explains that this "sameness" requirement among the puppets is key to the intended function of the puppets to help a child patient focus on the facial expression of each puppet and identify which puppet shows how he/she felt during a given experience. In addition, Solomon instructs that each puppet should be neutral with respect to social, cultural, racial, and ethnic background, so that any child patient of a given gender can identify with the character represented by the puppets (see Solomon at col. 2, lines 40-45).

Clearly, pulling aspects out of Figure 3 in Sparks and applying them to the puppets of Solomon undermines the primary purpose and function of the essential "sameness" functionality of the Solomon puppets, which is to help the child patient focus on the facial expression indicative of a given emotion.

Moreover, Solomon instructs that her puppets are to represent the child patient and how the child felt in a given situation. Solomon does not disclose that her puppets are to represent multiple characters and how those characters communicate via body language as in Figure 3 of Sparks.

Accordingly, why would one of skill in the art have incorporated the boy and girl of Spark's Figure 3 into a set of Solomon's puppets when doing so violates Solomon's same character requirement among each of the puppets? In addition, the boy and girl in Figure 3

of Sparks are hardly neutral with respect to one or more of social, cultural, racial, or ethnic background, as also required by Solomon.

Only impermissible hindsight could fuel the proposed combination of Solomon and Sparks, which is improper.

Even if the combination of Solomon and Sparks is somehow forced upon the Solomon reference, the combination would still fall short of each of Applicant's claims 1 and 13. Sparks does not even remotely teach, motivate, or suggest that the shape and color of playpieces, such as Solomon's puppets, should be unique among each of the playpieces and that a container could be used during the course of play to independently store or withdraw playpieces. Sparks merely mentions that body language shown in a statute such as Figure 3 can be used to communicate with the blind and blind-deaf (see Solomon at col. 4, lines 40-58). And Sparks does not even mention color of playpieces or a container for playpieces. Indeed, the Office Action relied on Sparks merely for the shape feature of claims 1 and 13.

In addition, Applicant notes that the Solomon/Sparks combination would clearly fall short of the shape feature of new claim 19. More specifically, a plurality of playpieces where each playpiece has a unique shape that is symbolic of the emotion indicated by the facial expression.

Not only does Sparks fail to cure the deficiencies of the Solomon reference, but the Shaver et al. reference likewise fails to cure the deficiencies of the Solomon reference.

With respect to combining Solomon and Shaver et al., the Office Action concludes that it would have been obvious to modify the Solomon puppets to each have a unique color because Figures 10a-10g show a set of disks where each disk has a unique color (see the Office Action at page 8). However, as discussed above, Solomon instructs that the character of her puppets is to be the same (i.e., the child patient) and that that her puppets should differ only by the facial expression indicative of a particular emotion. With respect to the container feature of claim 13, incorporating the methodology of Shaver et al. into Solomon would destroy the intended function of Solomon. In Solomon, scenes are illustrated on pages and a therapist asks a child patient to place a puppet (representing child patient) in the scene that describes how the child would feel in that situation (see Solomon at col. 2, lines

13-68). In contrast, the Shaver et al. reference does not illustrate scenes with pictures. In Shaver et al., a therapist verbally describes a situation to a child patient and the places disks into a representational figure such as a teddy bear (see Shaver et al. at col. 3-5). Accordingly, the Solomon and Shaver et al. are very different methodologies and not combinable. Only impermissible hindsight could fuel the proposed combination of Solomon and Shaver et al., which is improper.

Even if the combination of Solomon and Shaver et al. is somehow forced upon the Solomon reference, the combination would still fall short of each of Applicant's claims 1 and 13. As discussed below, Shaver et al. require that each disk within a given set of disks be unique in only one aspect (e.g., color), so it would be contrary to the instructions of Shaver et al. to combine more than one unique feature into a single playpiece. In other words, it would be contrary to the instructions of Shaver et al. to incorporate, e.g., both a unique color and unique facial expression into a single playpiece. And Shaver et al. do not even mention that any of their disks can have a unique shape. Indeed, the Office Action relied on Shaver et al. merely for the color feature of claims 1 and 13.

Finally, it is not seen how Shaver et al. can make it obvious to use multiple features in combination (e.g., unique facial expression and unique color) for a given puppet of Solomon when it is essential to the intended function of the Shaver et al. playpieces that features remain segregated among different groups of playpieces; and further that these groups must be presented to the user in succession, not in integrated fashion.

For instance, Shaver et al. disclose a particular receptacle into which certain kinds of objects can be inserted by a child in response to questions (see Shaver et al. at the Abstract). Shaver et al. describe the objects as "a series of sets of disks, with the sets being presented to the child seriatim [i.e., in series]." (See Shaver et al. at col. 4, lines 40-42) (Underlining added). More specifically, Shaver et al. describe four sets of disks in FIGS. 9a-9j, 10a-10g, 11a-11j, and 12a-12j. (See Shaver et al. at col. 4, line 43 to col. 5, line 13). As disclosed in Shaver et al., each disk within each of these sets of disks is unique with respect to the other disks of a given set based on only one aspect (see Shaver et al. at col. 4, line 43 to col. 5, line 13). Each disk within the set of disks represented in FIGS. 9a-9j depicts a facial expression expressing an emotion and a child is instructed to select a disk based on how the child feels about an event (see Shaver et al. at col. 4, lines

43-49). Each disk within the set of disks in FIGS. 9a-9j is not unique in color and is not unique in shape. After selecting a disk from the set of disks in FIGS. 9a-9j, a child is asked to select a disk from the set of disks illustrated in FIGS. 10a-10g (see Shaver et al. at col. 4, lines 58-62). Each disk in FIGS. 10a-10g has its own unique color, but does not include a facial expression and is not unique is shape (see Shaver et al. at col. 4, lines 58 and 59). After selecting a disk from the set of disks in FIGS. 10a-10g, a child is asked to select a disk from the set of disks illustrated in FIGS. 11a-11j or FIGS. 12a-12j to describe the intensity of the child's feeling (see Shaver et al. at col. 4, line 66 to col. 5, line 3). FIGS. 11a-11j illustrate disks having numbers on them and FIGS. 12a-12j illustrate disks having dots on them (see Shaver et al. at col. 5, lines 3-6). Each disk within the set of disks in FIGS. 11a-11j is not unique is color and is not unique in shape (see Shaver et al. at col. 5, lines 3-6). Each disk with the set of disks in FIGS. 12a-12j is not unique in color and is not unique in shape (see Shaver et al. at col. 5, lines 3-6).

Cases #1 and #2 described in Shaver et al. highlight why Shaver et al. instruct one skilled in the art to use such separate sets of disks. In Case #1, a patient selected a disk having a unique facial expression based on how she felt about an event and then selected a disk having a unique color from a separate set of disks based on how she felt about the event (see Shaver et al. at col. 4, lines 44-64). The patient selected a facial expression disk representing sad and a blue colored disk (see Shaver et al. at col. 4, lines 49-53). As can be seen, the patient herself selected a facial expression and a color based on how she felt. If a single set of disks were given to her where each disk was unique in color and facial expression, the combination would have to be anticipated, which is impossible, and pre-selected by someone other than the patient, which is contrary to the teachings of Shaver et al.

In Case #2, a patient selected a disk depicting a scared face because he felt scared and a brown disk from a separate set of disks because he had brown hair and eyes (see Shaver et al. at col.5, line 66 to col. 6, line 16). As can be similarly seen, the patient himself selected a facial expression and a color. Moreover, in Case #2, the patient selected a color based on the color of his hair and eyes, not how he felt. If a single set of disks were given to him where each disk was unique in color and facial expression, the

combination would have to be anticipated, which is impossible, and pre-selected by someone other than the patient, which is contrary to the teachings of Shaver et al.

Consequently, it is not seen how Shaver et al. can provide any teaching, motivation or suggestion to incorporate more features into a single puppet of Solomon when the Shaver et al. reference itself purposely segregates playpiece features among successive playpiece groups. It is not seen how Shaver et al. can provide any teaching, motivation or suggestion to incorporate more features into a single puppet of Solomon when doing so undermines the essential functionality of the Shaver et al. apparatus.

Accordingly, it is respectfully requested that the rejection of claims 1, 4, 10, 13-15 and 18 under 35 U.S.C. §103(a) as being unpatentable over Solomon in view of Sparks and Shaver et al., be withdrawn.

Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Solomon in view of Sparks and Shaver et al., as stated above, and further in view of Childswork/Childsplay "Feelings Frogs Game."

Claims 17 and 18 depend from independent claims 1 and 13, respectively. As discussed above, claims 1 and 13 are patentable over Solomon in view of Sparks and Shaver et al., so this rejection is first addressed with respect to claims 1 and 13.

As mentioned above, in comparison to independent claims 1 and 13, the Solomon puppets lack a unique color and unique shape among each of the puppets. In addition, in comparison to independent method claim 13, the Solomon method lacks a container into which the playpieces may be independently stored or withdrawn during the course of play.

The Childswork/Childsplay reference fails to cure the deficiencies of the Solomon reference because Childswork/Childsplay teaches away from the "sameness" requirement of Solomon discussed above. In brief, Solomon instructs that the character of her puppets is to be the same (i.e., the child patient) and that that her puppets should differ only by the facial expression indicative of a particular emotion, where the facial expression of the Solomon puppets includes eyes and mouth. In contrast to Solomon, the frogs of Childswork/Childsplay have different text messages and colors among each of the frogs, but the facial expression among each of the frogs includes only eyes and is the same facial expression, thereby teaching away from the puppets of Solomon.

With specific reference to the container feature of method claim 13, the Childswork/Childsplay "Feelings Frogs Game" does not even mention a container. Indeed, the Office Action relied on Childswork/Childsplay "Feelings Frogs Game" merely for the color feature of claims 1 and 13 and text feature of dependent claims 17 and 18.

Consequently, it is respectfully submitted that claims 1 and 13 are patentable over Solomon in view of Sparks and Shaver et al., as stated above, and further in view of Childswork/Childsplay "Feelings Frogs Game." It is respectfully submitted that dependent claims 17 and 18 are likewise patentable.

In addition, Applicant notes that the Childswork/Childsplay "Feelings Frogs Game" does not even remotely teach, motivate, or suggest the shape feature of new claim 19. More specifically, a plurality of playpieces where each playpiece has a unique shape that is symbolic of the emotion indicated by the facial expression.

Accordingly, it is respectfully requested that the rejection of claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Solomon in view of Sparks and Shaver et al., as stated above, and further in view of Childswork/Childsplay "Feelings Frogs Game," be withdrawn.

Former Grounds of Rejection

Claim Rejections - 35 USC § 112

Claims 6-9 and 12 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

Claims 6-9

Claims 6-9 stand rejected under 35 USC 112 on grounds that the shapes recited in these claims are indefinite. It is respectfully submitted that the terms "tear drop-shaped," "sun-shaped," "fire-shaped," and "ghost-shaped," as recited in claims 6-9, respectively, when considering the claims as a whole, and especially in view of the specification, satisfy Section 112. Moreover, it is respectfully submitted that reciting such shapes is a well-established practice as is evidenced by several issued U.S. patents noted below.

Each of claims 6-9 depends from claims 1 and 4 and each of claims 6-9 recites a specific shape of a playpiece that is generally symbolic of a particular emotion.

For example, claim 6 recites "wherein the playpiece generally symbolic of sadness is tear drop-shaped." (underlining added for emphasis). It is respectfully submitted that one of skill in the art would understand the scope of claim 6 when reading claim 6 as a whole. Reading claim 6 as whole (i.e., reading both claims 1 and 4 as well) indicates that the playpiece generally symbolic of sadness is tear drop-shaped and has, *inter alia*, a "unique visually discernable facial expression with respect to the other playpieces of the corresponding particular emotion, said facial expression comprising eyes and a mouth." (Underlining added for emphasis). One of skill would understand the scope of the term "tear drop-shaped" in the context of a playpiece generally symbolic of sadness that also includes, inter alia, a visually discernable facial expression corresponding to sadness, as claimed.

Similarly, it is respectfully submitted that one of skill in the art would understand the scope of each of claims 7-9 when reading each of claims 7-9 as a whole.

Representative users of the claimed toy are children, even young children. These youngsters have no difficulty identifying and discerning the recited shapes. If even youngsters can identify and discern amongst the claimed shapes, it seems implausible to assert that the claim terms are indefinite. Not only are these terms adequately described and illustrated in the specification in a manner that satisfies Section 112, but use of such terms is well-established in the patent literature:

The Specification: Applicant's specification provides exemplary embodiments of the specific shapes recited in claims 6-9 as follows:

- an exemplary embodiment of a "tear drop-shaped" playpiece, as recited in claim 6, is illustrated by the playpiece 16 in FIGS. 7a and 7b, which is generally symbolic of sadness and discussed throughout the specification, especially page 6, lines 6-10;
- an exemplary embodiment of a "sun-shaped" playpiece, as recited in claim 7, is illustrated by the playpiece 14 in FIGS. 5a and 5b, which is generally symbolic of happiness and discussed throughout the specification, especially page 5, lines 26-30;
- an exemplary embodiment of a "fire-shaped" playpiece, as recited in claim 8, is illustrated by the playpiece 18 in FIGS. 6a and 6b, which is generally symbolic of anger and discussed throughout the specification, especially page 6, lines 1-5; and

- an exemplary embodiment of a "ghost-shaped" playpiece, as recited in claim 9, is illustrated by the playpiece 20 in FIGS. 8a and 8b, which is generally symbolic of fear and discussed throughout the specification, especially page 6, lines 11-14.

Well-established practice in the patent literature: Reciting shapes such as "tear drop-shaped," "sun-shaped," "fire-shaped," and "ghost-shaped," is a well-established practice as is evidenced by the following exemplary issued U.S. patents:

- U.S. Pat. No. 5,092,778 to Shaver et al. (relied on as a secondary reference in a 35 U.S.C. §103 rejection in the Final Office Action (see, e.g., page 5 of the Final Office Action mailed September 28, 2004) and recites the shape term "teddy bear" in claim 5 to describe the shape of the "representational figure");
- U.S. Des. Pat. No. 436,020 to Thomas (Claim recites coil hose hanger with "sun shaped" head member);
- U.S. Pat. No. 5,011,211 to Svensson (Claim 3 recites that rigid body has a "U-shaped" cross-sectional profile);
- U.S. Pat. No. 6,561,922 to Bamber (Claim 3 recites that a portion of a golf club has a "tear drop-shaped cross-section.");
- U.S. Pat. No. 6,478,156 to Gebhardt (Claim 1 recites bags having a "tear-drop shaped support");
- U.S. Pat. No. 6,554,336 to Huppi (claim 16 recites a suction body having a jacket that is "heart shaped");
- U.S. Pat. No. 6,461,011 to Harrison (claim 1 recites an elongate "flame-shaped piece"); and
- U.S. Pat. No. 5,666,499 to Baudel et al. (claim 6 recites that a "ghost shaped image" is displayed).

It is respectfully submitted that the Examiner's indefiniteness arguments against these shape features is improper. First, the Examiner improperly challenges whether the patent literature shows that using shape terms is a well-established practice. According to the Final Office Action (see, e.g., page 7 of the Final Office Action mailed September 28, 2004):

> As support applicants list a variety of patents which use shape descriptive terminology, such as 'teddy bear', 'tear-drop shape', 'heart shape' among others. In response the examiner points out that none of the patents listed by the applicants appear to use terms such as, 'sun-shaped', 'fire shaped' or 'ghost shape' in the claim language.

It is respectfully submitted that this reasoning fails to fully appreciate the relevance of the issued patents cited by Applicant. The issued patents identified above were referenced to point out that reciting shapes the same as or similar to "tear drop-shaped," "sun-shaped," "fire-shaped," and "ghost-shaped," is a well-established practice in U.S. patent jurisprudence. Applicant note that, as indicated above, Thomas recites "sun shaped," Baudel et al. recite "ghost shaped image," and Harrison recites "flame-shaped piece," which is similar to fire-shaped.

Second, the Examiner also improperly challenges the scope of the shape terms used in the claims. The Final Office Action (see, e.g., page 8 of the Final Office Action mailed September 28, 2004) states that:

> [A] tear drop shape could be a variety of shapes such as a circle, oval, or blob with no clear defined boundaries, a sun shape can be a variety of shapes such as a circle, an oval, a half circle among others and as to a fire shape the examiner can't even begin to describe the variety of shapes that are encompassed by such a term.

In other words, inasmuch as the Final Office Action proposes that a variety of embodiments could be covered by the phrases "tear drop shaped," "sun-shaped," and "fire-shaped", the Office Action is concerned not with indefiniteness, but rather the fact that the claim terms cover different embodiments. Of course, the Examiner confuses claim breadth with indefiniteness, which is contrary to MPEP 2173.04:

> Breadth of a claim is not to be equated with indefiniteness... If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

Clearly, the fact that the claim terms might cover multiple embodiments is not a proper basis for making an indefiniteness rejection.

In conclusion, it is respectfully submitted that claims 6-9 are definite and comply with the requirements under 35 U.S.C. §112, second paragraph. It is respectfully requested that the rejection of claims 6-9 under 35 U.S.C. §112, second paragraph, as being indefinite, be withdrawn.

Claim 12

Applicant notes that, as indicated above, claim 12 stands rejected under 35 U.S.C. §112, but that the Final Office Action does not address such rejection. Applicant has reviewed the claim, and it is respectfully submitted that the claim satisfies Section 112. It is respectfully requested that the rejection of claim 12 under 35 U.S.C. §112, second paragraph, be withdrawn.

Claim Rejections - 35 USC § 101

Claims 13-16 and 18 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

According to the Final Office Action (see, e.g., page 3 of the Final Office Action mailed September 28, 2004), claims 13-16 and 18 are directed to non-statutory subject matter. It is respectfully submitted that claims 13-16 and 18 are directed to a method of psychological/therapeutic treatment constituting statutory subject matter within the scope of §101.

Independent claim 13 recites a "method of exploring emotional experience, comprising the steps of (a) providing a toy ...; and (b) interacting with the toy to explore an emotional experience." (Underlining added for emphasis).

That is, claim 13 relates to a psychological method of treatment that recites specific steps to explore and treat an emotional condition of a patient. Such a method is therapeutic in nature. As discussed above in the Summary of Claimed Subject Matter, providing a toy according to the present invention to explore an emotional experience enhances a person's (e.g., a child's) ability to connect a specifically identified emotion to a specific concrete symbol of that emotion (i.e., playpiece) during an otherwise fluid, sometimes overwhelming emotional experience. (See the specification at, e.g., page 7, lines 10-15.) Enhancing the child's ability to make this connection between a concrete

symbol and a corresponding emotion helps provide an emotional experience that is more manageable and helps an adult (e.g., psychologist) or child plan for responsive actions. (See the specification at, e.g., page 2, lines 21-30, and page 7, lines 7-18.)

Psychological methods of practice have long been deemed to constitute patentable subject matter. The United States Patent Office (USPTO) even has at least one applicable class and subclass for corresponding patents in this field. For example, reference is made to the many patents in class 434, subclass 236. Just a few representative patents in this class/subclass include:

- U.S. Pat. No. 6,626,678 to Forbes et al. includes, e.g., claim 1, which recites "[a] therapeutic method comprising ... to use as a cognitive activity aid an article that comprises a plurality of pieces ....";
- U.S. Pat. No. 6,540,518 to Shepherd includes, e.g., claim 13, which recites "[a]n educational method of teaching individuals their emotions ....";
- U.S. Pat. No. 6,626,677 to Morse et al. includes, e.g., claim 1, which recites "[a] method of enhancing work related leadership, communication and creative skills ...."; and
- U.S. Pat. No. 6,602,076 to Adams includes, e.g., claim 1, which recites "[a] method of teaching a fundamental skill to a student ...."

It is not seen how the Examiner can disqualify the claimed subject matter under Section 101 when the USPTO thinks otherwise via patents it has issued and via the class/subclass indexing the USPTO provides for these patents. The claims clearly recite patentable subject matter under Section 101.

The Examiner's arguments to the contrary not only conflict with established USPTO infrastructure, but also are improperly based upon case law that is inappositely applied to the present claims. According to the Final Office Action (see page 8 of the Final Office Action mailed September 28, 2004):

> Applicants further argue that since patents drawn to psychological methods have been issued that have not achieved a specific tangible result then therefore their method claims are statutory under 35 USC 101. In response the examiner points out that a recently developed test for the determination

> of patent eligible matter is whether the invention produces a useful, concrete and tangible result. See e.g., State Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596 (Fed. Cir. 1998); AT&T Corp. v. Excel Communications Inc., 50 USPQ2d 1447 (Fed. Cir. 1999).

The Final Office Action also cites *In re Warmerdam*, 31 USPQ2d 1754 (Fed. Cir. 1994) and *In re Schrader*, 30 USPQ2d 1455 (Fed. Cir. 1994) in support of the §101 rejection. (See page 4 of the Final Office Action mailed September 28, 2004.)

It is respectfully submitted that the line of cases relied on in the Final Office Action (see pages 4 and 8 of the Final Office Action mailed September 28, 2004) apply to mathematical algorithms and, therefore, do not apply to Applicant's claimed invention. The "useful, concrete, and tangible" test referred to in the Final Office Action (see page 8 of the Final Office Action mailed September 28, 2004) above was cited in the *State Street* case with regard to "The 'Mathematical Algorithm' Exception," which is a judicially-created exception to statutory subject matter. (See *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998)). In particular, the test is stated as follows:

> In *Diehr*, the Court explained that certain types of mathematical subject matter, standing alone, represent nothing more than abstract ideas until reduced to some type of practical application, i.e., 'a useful, concrete and tangible result.' (See *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 47 USPQ2d 1596, 1600-01 (Fed. Cir. 1998) (citing *In re Alappat*, 31 USPQ2d 1545, 1557 (Fed. Cir. 1994)). (Underlining added for emphasis).

And the cases cited in the Final Office Action (see pages 4 and 8 of the Final Office Action mailed September 28, 2004) in support of the §101 rejection also are related to mathematical algorithms as follows:

- *In re Abele,* 214 USPQ 682, 684 (CCPA 1982) involves an improvement in CAT scan imaging technique through the use of a weighting function in the calculations producing an image;
- *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998) involves the transformation of data, representing discrete dollar amounts, through a series of mathematical calculations into a final share price;
- *AT&T Corp. v. Excel Communications, Inc.,* 50 USPQ2d 1447, 1452 (Fed. Cir. 1999) involves a long distance telephone billing process that includes applying Boolean algebra to data to determine a value that is used to create a signal useful for billing purposes;

- *In re Warmerdam*, 31 USPQ2d 1754, 1755 (Fed. Cir. 1994) involves a method and apparatus for controlling the motion of objects and machines; and
- *In re Schrader*, 30 USPQ2d 1455, 1456, 1458 (Fed. Cir. 1994) involves a method for competitively bidding on items that uses a mathematical algorithm.

To re-emphasize, the present claims do not recite mathematical algorithms per se, but rather embody methods of psychological/therapeutic treatments. The patentability of claims embodying such subject matter is well established. Accordingly, it is respectfully requested that the rejection of claims 13-16 and 18 under 35 U.S.C. §101 be withdrawn.

Claim Rejections - 35 USC § 103

Claims 1, 4, and 6-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Van Hoose (U.S. Pat. No. 4,917,607) in view of Shaver et al.

Claims 1, 4, and 6-16 stand rejected under 35 USC 103 as being obvious over Van Hoose in view of Shaver et al. Nowhere does Van Hoose teach the use of playpieces having at least the trio of features being claimed. However, in essence, the rejection states that Shaver et al. makes it obvious to incorporate more features into the Van Hoose playpieces in order to arrive at the subject matter of the claims.

This rejection is traversed because:

(1) It is not seen how Shaver et al. can make it obvious to use more features in combination when it is essential to the intended function of the Shaver et al. playpieces that features remain segregated among different groups of playpieces; and further that these groups must be presented to the user in succession, not in integrated fashion; and

(2) Even if the combination were to be made, the claims would not be met in that neither document teaches a playpiece group in which the playpieces are uniquely colored in combination with a unique facial expression.

Independent claims 1 and 13 each recite a particular toy that includes, *inter alia*, a plurality of playpieces such that each playpiece is generally symbolic of a particular emotion and each playpiece has the following combination of features:

1) a unique color with respect to the other playpieces,

2) a unique shape with respect to the other playpieces, and

3) a unique visually discernible facial expression with respect to the other playpieces of the corresponding particular emotion, said facial expression comprising eyes and a mouth.

As acknowledged by the Final Office Action (see pages 5 and 6 of the Final Office Action mailed September 28, 2004), Van Hoose fails to teach using the combination of all three of these features in the same group of playpieces. Specifically, the objects 29, 31, 33, 35, 37, and 39 disclosed by Van Hoose are not unique in color with respect to each other because both objects 31 (lips) and 35 (heart) are red (see Van Hoose at col. 2, lines 40-44 and Figure 3). Also, none of objects 29, 31, 33, 35, 37, or 39 have a facial expression, especially a unique visually discernible facial expression with respect to the other objects that includes at least eyes and a mouth. (See Figure 3 of Van Hoose.)

The Shaver et al. reference fails to cure the deficiencies of the Van Hoose reference. It is improper to use Shaver et al. as a basis to combine more features into the playpieces of Van Hoose inasmuch as Shaver actually teaches away from incorporating more features into individual playpieces. It is essential to the intended function of the Shaver et al. apparatus that playpiece features remain segregated to a degree among different playpiece groups, and these different, segregated groups must be presented to the user in succession.

For instance, Shaver et al. disclose a particular receptacle into which certain kinds of objects can be inserted by a child in response to questions. (See Shaver et al. at the Abstract.) Shaver et al. describe the objects as "a series of sets of disks, with the sets being presented to the child seriatim [i.e., in series]." (See Shaver et al. at col. 4, lines 40-42.) (Underlining added). More specifically, Shaver et al. describe four sets of disks in FIGS. 9a-9j, 10a-10g, 11a-11j, and 12a-12j. (See Shaver et al. at col. 4, line 43 to col. 5, line 13). As disclosed in Shaver et al., each disk within each of these sets of disks is unique with respect to the other disks of a given set based on only one aspect (see Shaver et al. at col. 4, line 43 to col. 5, line 13). Each disk within the set of disks represented in FIGS. 9a-9j depicts a facial expression expressing an emotion and a child is instructed to select a disk based on how the child feels about an event. (See Shaver et al. at col. 4, lines 43-49.) Each disk within the set of disks in FIGS. 9a-9j is not unique in color and is

not unique in shape. After selecting a disk from the set of disks in FIGS. 9a-9j, a child is asked to select a disk from the set of disks illustrated in FIGS. 10a-10g. (See Shaver et al. at col. 4, lines 58-62.) Each disk in FIGS. 10a-10g has its own unique color, but does not include a facial expression and is not unique is shape. (See Shaver et al. at col. 4, lines 58 and 59.) After selecting a disk from the set of disks in FIGS. 10a-10g, a child is asked to select a disk from the set of disks illustrated in FIGS. 11a-11j or FIGS. 12a-12j to describe the intensity of the child's feeling. (See Shaver et al. at col. 4, line 66 to col. 5, line 3.) FIGS. 11a-11j illustrate disks having numbers on them and FIGS. 12a-12j illustrate disks having dots on them. (See Shaver et al. at col. 5, lines 3-6). Each disk within the set of disks in FIGS. 11a-11j is not unique is color and is not unique in shape. (See Shaver et al. at col. 5, lines 3-6). Each disk with the set of disks in FIGS. 12a-12j is not unique in color and is not unique in shape. (See Shaver et al. at col. 5, lines 3-6).

Shaver et al. do not do not cure the deficiencies of Van Hoose because, e.g., Shaver et al. do not disclose a set of disks where each disk has 1) a unique color with respect to the other disks and 2) a unique visually discernible facial expression with respect to the other disks that includes at least eyes and a mouth. As discussed above, Shaver et al. describe two separate sets of disks where each disk in one set has a unique color (FIGS. 10a-10g), yet does not include a facial expression, and each disk in the other set has a unique facial expression (FIGS. 9a-9j), yet does not include a unique color.

There is no motivation or suggestion to modify a set of disks described by Shaver et al. such that each disk in the set has 1) a unique color with respect to the other disks and 2) a unique visually discernible facial expression with respect to the other disks that includes at least eyes and a mouth because that would be contrary to the specific instructions of Shaver et al. As discussed above, Shaver et al. specifically instruct one skilled in the art to first present a child with a first set of disks (FIGS. 9a-9j), then a second set of disks (FIGS. 10a-10g), and then a third set of disks (FIGS. 11a-11j or FIGS. 12a-12j). (See Shaver et al. at col. 4, line 43 to col. 5, line 13.) As also discussed above, each disk in the set illustrated in FIGS. 9a-9j has a unique facial expression with respect to the other disks, yet does not have a unique color, and each disk in the set illustrated in FIGS. 10a-10g has a unique color, yet does not even have facial expression.

Cases #1 and #2 described in Shaver et al. highlight why Shaver et al. instruct one skilled in the art to use such separate sets of disks. In Case #1, a patient selected a disk having a unique facial expression based on how she felt about an event and then selected a disk having a unique color from a separate set of disks based on how she felt about the event. (See Shaver et al. at col. 4, lines 44-64.) The patient selected a facial expression disk representing sad and a blue colored disk. (See Shaver et al. at col. 4, lines 49-53.) As can be seen, the patient herself selected a facial expression and a color based on how she felt. If a single set of disks were given to her where each disk was unique in color and facial expression, the combination would have to be anticipated, which is impossible, and pre-selected by someone other than the patient, which is contrary to the teachings of Shaver et al.

In Case #2, a patient selected a disk depicting a scared face because he felt scared and a brown disk from a separate set of disks because he had brown hair and eyes. (See Shaver et al. at col. 5, line 66 to col. 6, line 16.) As can be similarly seen, the patient himself selected a facial expression and a color. Moreover, in Case #2, the patient selected a color based on the color of his hair and eyes, not how he felt. If a single set of disks were given to him where each disk was unique in color and facial expression, the combination would have to be anticipated, which is impossible, and pre-selected by someone other than the patient, which is contrary to the teachings of Shaver et al.

It is not seen how Shaver et al. can provide any teaching, motivation or suggestion to incorporate more features into the same playpiece group of Van Hoose when the Shaver et al. reference itself purposely segregates playpiece features among successive playpiece groups. It is not seen how Shaver et al. can provide any teaching, motivation or suggestion to incorporate more features into the same playpiece group of Van Hoose when doing so undermines the essential functionality of the Shaver et al. apparatus.

In addition, it is respectfully submitted that even if the Van Hoose reference is combined with Shaver et al. reference, the resultant combination would lack a playpiece group in which the playpieces are uniquely colored in combination with a unique facial expression. As discussed above, the Van Hoose objects are not unique in color and do not have a facial expression, and the disks having unique color and facial expressions in Shaver et al. are in separate sets of disks, respectively. Therefore, because Van Hoose

and Shaver et al., alone or in combination, do not teach, motivate, or suggest all of the claim features in claim 1 or claim 13, a *prima facie* case of obviousness has not been established.

Accordingly, it is respectfully requested that the rejection of claims 1, 4, and 6-16 under 35 U.S.C. §103(a) as being unpatentable over Van Hoose in view of Shaver et al. be withdrawn.

Claims 17 and 18 stand rejected under 35 U.S.C. §103(a) as being obvious over Van Hoose in view of Shaver et al. and further in view of Childswork/Childsplay "Feelings" Frog game. Claims 17 and 18 depend from independent claims 1 and 13, respectively. As discussed above, claims 1 and 13 are patentable over Van Hoose in view of Shaver et al. so this rejection is first addressed with respect to claims 1 and 13.

Claims 1 and 13 are also patentable over Van Hoose in view of Shaver et al. and further in view of the Childswork/Childsplay reference because the Childswork/Childsplay reference does not overcome the shortcomings of Van Hoose and Shaver as detailed above. More specifically, Childswork/Childsplay reference fails to teach, motivate or suggest modifying the objects 29, 31, 33, 35, 37, and 39 disclosed in Van Hoose so that they have the following claimed combination of all three features: a unique color with respect to each other, a unique shape with respect to each other, and a unique visually discernible facial expression with respect to the other objects that includes at least eyes and a mouth.

The Childswork/Childsplay reference discloses six frogs where each frog has the same set of eyes, yet no mouth, has textual information indicative of a different emotion, is unique in color, yet all six frogs have the same body shape. (See the Childswork/Childsplay reference at page 22).

First, there is no motivation or suggestion to modify the objects 29, 31, 33, 35, 37, and 39 disclosed in Van Hoose so that they are unique in color based on the Childswork/Childsplay reference. As discussed above, the lips 31 and heart 35 disclosed in Van Hoose are both red. The lips 31 and heart 35 can be distinguished from each other based on shape. The frogs disclosed in Childswork/Childsplay are all the same shape but can be distinguished based on color and textual information. The Childswork/Childsplay

reference provides no guidance or reason for one of skill in the art to change to the color of lips 31 and/or heart 35 from red to another color so that the objects are unique in color. Indeed, absent instructions to the contrary, symbols of lips and hearts are commonly associated with the color red.

Second, the frogs disclosed in the Childswork/Childsplay reference do not have a unique visually discernible facial expression with respect to the other frogs of a corresponding particular emotion where the facial expression includes at least eyes and a mouth, as required by Applicant's claims. The frogs disclosed in the Childswork/Childsplay reference all have the same sets of eyes, which are not indicative of the corresponding emotion displayed in the text. (See the Childswork/Childsplay reference at page 22). Moreover, the Childswork/Childsplay reference does not unambiguously describe that the frogs even have a mouth.

There is no motivation or suggestion to modify the frogs in the Childswork/Childsplay reference to have a unique visually discernible facial expression with respect to the other frogs of a corresponding particular emotion where the facial expression includes at least eyes and a mouth, as required by Applicant's claims. Indeed, the Office Action merely relied on the Childswork/Childsplay reference as disclosing frogs with unique color and having textual information indicative of a particular emotion. (See page 7 of the Final Office Action mailed September 28, 2004).

Finally, as noted above, the Childswork/Childsplay reference illustrates the frogs as all having the same shape. (See the Childswork/Childsplay reference at page 22). Therefore, modifying the objects 29, 31, 33, 35, 37, and 39 disclosed in Van Hoose with the frogs disclosed in Childswork/Childsplay teaches away Applicant's claims.

Accordingly, it is respectfully submitted that claims 1 and 13 are patentable over Van Hoose in view of Shaver et al. and further in view of the Childswork/Childsplay reference. Likewise, it is respectfully submitted that dependent claims 17 and 18 are also patentable over Van Hoose in view of Shaver et al. and further in view of the Childswork/Childsplay reference.

It is respectfully requested that the rejection of claims 17 and 18 under 35 U.S.C. §103(a) as being unpatentable over Van Hoose in view of Shaver et al. and further in view of the Childswork/Childsplay reference be withdrawn.

Conclusion

In view of the above remarks and amendments, it is respectfully submitted that the claims and the present application are in condition for allowance. Approval of the application and allowance of the application is earnestly solicited. In the event that a phone conference between the examiner and the Applicant's undersigned attorney would help resolve any remaining issues in the application, the Examiner is invited to contact the undersigned.

Respectfully Submitted,

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